

REMARKS/ARGUMENTS

Responsive to the Office Action mailed May 17, 2007:

I. CLAIM STATUS

Claims 1 -10 are pending, and stand rejected under 35 USC 103(a). Independent claims 1,6, and 10 are currently amended.

A. The Office Action rejected claims 1-10 under 35 USC 103(a) as being unpatentable over *Hayka* (US Patent No. 5,688,118) in view of *Hon* (US Patent No. 4,360,345) and *Neustadter* (US Patent No. 4,902,232)

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.¹ If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.²

First, the Applicant asserts that there is no *prima facie* case of obviousness available for the currently amended independent claims, and the claims that depend there from. Second, in addition or in the alternative, the Applicant asserts that the original rejection of the claims fails to present a *prima facie* case because there is no suggestion modification or teaching (either explicit or implicit) to combine the references to achieve the claimed invention. While *KSR Int'l Co. v. Teleflex Inc. et.al.*³ modified the landscape of obviousness analysis, the Supreme Court has not done away with the need for a reasoned statement proposing the combination, and the Applicant's disclosure cannot form the basis for that combination.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations.

¹MPEP Sec. 2142.

² Id.

³ 550 U.S. ____ (2007)

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.⁴

As to claim 1:

1. The references, even if combined, do not teach or disclose every claimed element.

The Office Action admits that Hayka, the primary reference

does not specifically disclose the kit including a hard copy of printed instructions on how to use the kit and steps to accomplish discipline in the advanced dental procedure, a dental filling material for the restorative procedure on the prepared dentition, and dental instruments for placement control and shaping of the dental filling material in the restorative procedure.

The Office Action relies on Neustadter to supply the missing elements of:

a dental filling material for the restorative procedure on the prepared dentition; and
dental instruments for placement, control, and shaping of the dental filling material in the restorative procedure.

Neustadter does not expressly disclose either of these elements. The Examiner relies on inherency to supply the missing elements:

In a system where students are performing the skill of filling cavities of a dental training model, it is inherent of the system to comprise dental filling material and instruments for filling the cavity.

Applicant respectfully disagrees.

The Hayka reference shows that in such a system it is not inherent to comprise dental filling material and instruments for filling the cavity. By the very fact that Hayka does not teach these elements, these elements are not inherent in such a system.

The MPEP states:

⁴Id. (emphasis supplied)

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).⁵

The fact that Hayka's system does not disclose the claimed elements shows that these elements are not necessarily inherent in a system such as Neustadter.

Thus, the references, even if combined, do not teach each and every element of claim 1.

The amendments to the claims further relate to problems and the solution offered by the present invention as described in the Application. For example, the kit is portable in the sense of being available for use in an at home learning environment. The Application, page 2, identified the failings of conventional training for continuing education for dental professionals, and the need for a solution presented by the invention as:

"Currently continuing education is conducted in class rooms, hotels, and in labs away from the work setting . . . More specifically in dentistry, the established method of teaching new and/or advanced techniques has been through the bringing together of teacher and student in various venues, i.e., dental schools, convention centers, hotel rooms, and dental offices, to name a few.

* * *

There is a need to supply a Kit of material to permit a participant to learn, feel, and accomplish a restorative dental procedure in a private setting of the participants choosing rather than traveling to, joining into, or being forced to be present in a structured venue. The participant, at his/her own time and place, will: read, listen to, or watch, the step-by-step procedure in order to facilitate the goals set out in the PCE course for accomplishment of a specific dental restorative procedure." [emphasis added]

The prior art cited in the instant Office Action does not disclose, suggest, or teach all of the elements of the currently amended independent claims. For example, *Hayka*, the primary reference is an image, sound, and feeling simulation system for dentistry that is not portable to an at-home learning environment. See, e.g., col. 10 lines 17- 21 (compressed gas unit for rotating the drill).

⁵ MPEP § 2112

Claim 1 is allowable. Claims 2-5 contain additional elements or limitations beyond allowable claim 1 and are also allowable.

Claim 6 is allowable for at least the reasons given above in regard to claim 1. Claims 7-9 contain additional elements or limitations beyond allowable claim 6 and are also allowable.

Claim 10 is allowable because the cited references do not disclose the claimed method comprising steps (a) – (d), wherein the steps are carried out in a private setting of the participant's choosing and not in a structured venue.

2. The Examiner has not provided a teaching, suggestion, or motivation to make the combination.

Although evidence of a motivation to combine need not be found in the prior art reference themselves, if it is found in the knowledge of one of ordinary skill in the art or, in some cases, from the nature of the problem to be solved, the Office Action must do more than simply discuss the ways that the multiple prior art references can be combined to read on the claimed invention. Rather, the Office Action must point out “specific information in [the two references] that suggest the combination.”⁶ “‘The Board [must] explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination.’”⁷

In *KSR Int'l Co. v. Teleflex Inc. et.al.*⁸, the Court re-affirmed that:

Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.⁹

Although common sense directs one to look with care at a patent application that claims as innovation the combination of two

⁶ See *Dystar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356,1366, 80 USPQ2d 1641, ___ (Fed. Cir. 2006) (citing *In re Dembiczak*, 175 F.3d 994, 999-1000 (Fed. Cir. 1999) (emphasis supplied))

⁷ *Id.* at 1367 (citing *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998))

⁸ 550 U.S. ___ (2007)

⁹ *Id.*

known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.¹⁰

The Examiner has not provided a reason that would have prompted a person of ordinary skill in the art to combine Hon and Neustadter with Hayka. The Examiner has merely stated the teachings of Hon and Neustadter without explicitly providing a reason for making the combination. For example, Hayka discloses an artificial tooth 58, so it is not immediately clear why one of ordinary skill in the art would be motivated to combine Neustadter, which also discloses an artificial tooth, with Hayka.

3. The Examiner has not applied all *Graham* factors in finding obviousness.

The Federal Circuit routinely vacates conclusions of obviousness when the factfinder failed to make *Graham* factor findings.¹¹ This is especially so when the factfinder makes conclusory statements that “‘do not fulfill the agency’s obligation’ to explain all material facts relating to a motivation to combine.”¹²

The Supreme Court has re-affirmed this need:

Often, it will be necessary for a court to look to ... the background knowledge possessed by a person of ordinary skill in the art...in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.¹³

The Office Action has not properly applied the test of *Graham v. John Deere Co.*¹⁴ While an earlier Office Action, April 4, 2006, summarized four *Graham* factors, the Office Action did not make any findings of fact in regard to the factors. The MPEP requires that the Office Action

¹⁰ *Id.*

¹¹ *Dystar*, 464 F.3d 1366 and cases cited therein.

¹² *Id.*

¹³ KSR, 550 U.S. ____ (2007)

¹⁴ *Graham v. John Deere Co. of Kansas City*, 216 F.Supp. 272, 137 U.S.P.Q. 864

to do so.¹⁵ The Office Action has made no findings of the level of ordinary skill in the art,¹⁶ and it is thus deficient.

C. Prior Art Not Of Record

Lastly, the Applicant notes that the Office Action presented prior art that was "made of record and not relied." Since these references are not relied upon, the Applicant has not addressed the references in this response.

III. Conclusion

For the above reasons, Applicant respectfully requests the allowance of all claims and the issuance of a Notice of Allowance.

The United States Patent & Trademark Office is authorized to debit any additional fees or credit any overpayment to Briggs & Morgan's Deposit Account No. 023732.

Respectfully submitted,

Dated: _____

9 Aug 07

By _____

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¹⁵ MPEP § 2141

¹⁶ MPEP § 2141.03